



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/356,940	07/19/1999	JOSEPH GRAJEWSKI	438P470	8491

28264 7590 08/10/2004

BOND, SCHOENECK & KING, PLLC  
ONE LINCOLN CENTER  
SYRACUSE, NY 13202-1355

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER
----------

ART UNIT	PAPER
----------	-------

20

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

Per the Advisory Action mailed of March 17, 2004, the claim amendment received on February 20, 2004 has been entered in full.

It was though that the amendment would serve to overcome the 112, first paragraph rejection advanced in the final Office Action. However, upon closer review of the amendment, the term "in sequence", as added to independent claims 33 and 45, while clarifying one aspect of the rejection, does not render the 112 rejection completely moot. Thus, the 112 rejection will be maintained through appeal.

Brian Werner  
Primary Examiner  
Art Unit 2621

**BRIAN WERNER  
PRIMARY EXAMINER**

**Notification of Non-Compliance  
With 37 CFR 1.192(c)**

Application No.

09/356,940

Applicant(s)

GRAJEWSKI ET AL.

Examiner

Brian P. Werner

Art Unit

2621

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The Appeal Brief filed on 26 May 2004 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☒ A single ground of rejection has been applied to two or more claims in this application, and
  - (a) ☒ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

  
**BRIAN WERNER  
PRIMARY EXAMINER**

**Attachment**  
**Notification of Non-Compliance with 37 CFR 1.192(c)**

**Block 6:**

A single grounds of rejection is applied to two or more claims. The Appeal Brief, under the Heading "Grouping of Claims", states that "the independent claim in each group is representative of the remaining claims", and the "dependent claims stand or fall with the independent claim". However, in the "Argument" section of the Brief, independent claims 49, 50-52, and 54 are argued separately at sections III and IV. The arguments for claims 49, 50-52, and 54 are moot, if in fact the dependent claims do stand or fall with the independent claims, and should be deleted to avoid confusion. However, should the appellant contend that dependent claims 49, 50-52, and 54 stand or fall separately, separate arguments for patentability should be advanced (MPEP 1206) and the "grouping of the claims" section so clarified.

**Block 9:**

The appellant's grouping of the claims is confusing, particularly in light of the arguments, and requires clarification.

First, it is noted that a "group", for purposes of appeal, is a group of two or more claims that stand or fall together, according to a representative claim in the group (37 CFR 1.192(c)(7)).

The Appeal Brief, under the Heading "Grouping of Claims", states, "the rejected claims have been grouped together in each of the rejections." Given that there are seven (7) separate grounds of rejection, does that mean there are seven (7) groups? This would not be proper, as explained below.

Then, the Appeal Brief states, "the independent claim in each group is representative of the remaining claims", and the "dependent claims stand or fall with the independent claim". However, independent claims 45 and 53 are both rejected on the same grounds, so which of these claims is the representative claim?

Finally, in the "Argument" section of the Brief, the Appellant focuses primarily upon claim 45, by arguing that the McIntosh and He combination is improper, and that the McIntosh and Noll combination is improper (i.e., at sections I and II of the arguments). Then, the appellant argues dependent claim 49 (section III of the arguments), despite having noted that the dependent claims stand or fall with the independent claim. Then, the appellant argues dependent claims 50-52 and 54 (section IV of the arguments), again despite having noted that the dependent claims stand or fall with the independent claim. Then, the appellant argues independent claim 33 (section V of the arguments). However, no further arguments are presented as to why 33 is separately patentable over claim 45, and the argument appear to be based entirely on the McIntosh and He combination as applied to claim 45.

Thus, in light of the appellant's statement of claim grouping, and in light of the manner in which the appellant has presented the arguments, it is not clear what the

Art Unit: 2621

claim groupings are, and which claims stand or fall together, and which are separately patentable (and why).


From the arguments section, it would appear that there is only a single group of claims, all of which stand or fall with independent claim 45. That is, all of the claims stand or fall with McIntosh and He as applied to claim 45, and claims 46-54 stand or fall with McIntosh and Noll as applied to claim 45. If this is correct, it should be so stated in the Appeal Brief; and dependent claims should not be separately argued. If this is not the case, then the appellant should make eminently clear how many groups there are, what claims are contained in each group, what the representative claim of the groups is, and which claims stand or fall with that representative claim. The claim grouping should be clearly laid out and unambiguous, and a nebulous statement to be sorted out by the examiner and the Board will not suffice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Werner whose telephone number is 703-306-3037. The examiner can normally be reached on M-F, 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H. Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian Werner  
Primary Examiner  
Art Unit 2621  
7/29/2004



BRIAN WERNER  
PRIMARY EXAMINER